

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Rob LeLonde, et al.

Serial No. 10/708,968

Filed: April 4, 2004

For: Control of Desired Marketing
Electronic Mail Through Use of
Anonymous Recipients and
Public Key Infrastructure (PKI)

Date: July 5, 2007

Docket No.

Group Art Unit: 2135

Examiner: Suman Debnath

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

SIR:

In response to the Office Action mailed March 21, 2007, Applicants respectfully requests reconsideration of the current Application. Please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims starts on page 2.

Remarks/Arguments start on Page 5.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on:

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Amendments to the Claims:

This listing of claims will replace all prior versions and listings of claims:

1. (Cancelled)
2. (Cancelled)
3. (Cancelled)
4. (New) A computer implemented system for reducing unwanted email comprising:
a means for providing a temporary email address to a user;
a means for forwarding an email addressed to the temporary email address to a forwarding email address for the user; and
a means for deleting the temporary email address.
5. (New) The system in claim 4 wherein:
the means for deleting the temporary email address comprises:
a means for expiring the temporary email address.
6. (New) The system in claim 4 wherein:
the means for deleting the temporary email address comprises:
a means for allowing the user to delete the temporary email address.
7. (New) The system in claim 4 wherein:
the system further comprises:
a means for providing a forwarding rule corresponding to the temporary email address; and
the means for forwarding only forwards the email destined to the temporary email address when it corresponds to the forwarding rule for the temporary email address.

8. (New) A method of automatically reducing unwanted email comprising:
providing a temporary email address to a user;
forwarding an email addressed to the temporary email address to a
forwarding email address for the user; and
deleting the temporary email address.
9. (New) The method in claim 8 wherein:
deleting the temporary email address comprises:
expiring the temporary email address.
10. (New) The method in claim 8 wherein:
deleting the temporary email address comprises:
allowing the user to delete the temporary email address.
11. (New) The method in claim 8 wherein:
the method further comprises:
providing a forwarding rule corresponding to the temporary email
address; and
forwarding only forwards the email destined to the temporary email address
when it corresponds to the forwarding rule for the temporary email
address.
12. (New) A computer software storage medium containing computer
instructions for reducing unwanted email, wherein the computer instructions
comprise:
a means for providing a temporary email address to a user;
a means for forwarding an email addressed to the temporary email address to
a forwarding email address for the user; and
a means for deleting the temporary email address.
13. (New) The computer software storage medium in claim 12 wherein:
the means for deleting the temporary email address comprises:
a means for expiring the temporary email address.

14. (New) The computer software storage medium in claim 12 wherein:
the means for deleting the temporary email address comprises:
a means for allowing the user to delete the temporary email address.

15. (New) The computer software storage medium in claim 12 wherein:
the system further comprises:
a means for providing a forwarding rule corresponding to the
temporary email address; and
the means for forwarding only forwards the email destined to the temporary
email address when it corresponds to the forwarding rule for the
temporary email address.

REMARKS

Claims 1-3 were pending in the application. In the Office Action dated March 7, 2007, the claims were rejected under 35 U.S.C. §§ 101, 102(b), and 112 ¶ 2. In addition, a new oath/declaration was required since the one filed was not done in accordance with 37 CFR 1.66.

A new declaration is filed along with this amendment.

Claims 1-3 have been cancelled, and claims 4 through 15 added. Independent claims 4, 8, and 12 replace claims 1 and 2.

Applicants respectfully submit that the wording of claims 4 through 15 conform to 35 U.S.C. § 101 and § 112 ¶ 2 and therefore request that the rejection of the claims on those grounds be withdrawn. Independent claim 4 claims a “*computer implemented system for reducing unwanted email*”. It is statutory subject matter since it clearly claims a hardware device. Independent claim 8 claims “*A method of automatically reducing unwanted email*”. Again, this is statutory since it involves a process that is implemented on computers. Finally, independent claim 12 is to “*A computer readable storage medium*” containing computer instructions for practicing the invention. A computer readable storage medium is by necessity a tangible medium, and therefore is statutory subject matter. Indeed, this is a classic *in re Beauregard* type claim. All the other claims are dependent upon these three independent claims, and are therefore also statutory subject matter. Applicants therefore request that the rejection of the claims on this basis be withdrawn.

Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nemovicher (Pub. No. US 2002/0007453 A1). As to claim 1, it was suggested that *Nemovicher discloses method for providing consumer anonymity via secure e-mail forwarding (FIG. 1, [0039])*. However, paragraph 0039 states:

[0039] The system according to the present invention shown in FIG. 1 permits secure e-mails to be sent from sending computer 400 and received in receiving computer 405. Central server 52 provides secure authentication, virus checking, time and date stamping as well as flexibility with regard to the type of system used by the message sender and recipient. The system operates by encrypting an e-mail message at sending computer 400 and sending the encrypted message to central server 52 through communication network 130. The encrypted e-mail message is unpacked, verified and virus checked, before being repackaged for transmission to receiving computer

405. Once the e-mail message is repackaged in a secure format, it is transmitted through communication network 130 via node 134 to receiving computer 405. The recipient is notified of the encrypted e-mail and, according to one embodiment of the present invention, is provided with instructions on opening and unencrypting the e-mail message, if necessary. The system operates with a number of different hardware and software platforms by which receiving computer 405 sends and receives e-mail messages.

The independent claims require that a temporary email address be provided a user, that mail to that email address be forwarded to the user, and that the temporary email address be capable of being deleted. It can thus be seen that this reference does not mention any of these elements. It does not disclose assigning a temporary email address, nor does it disclose forwarding email to that temporary email address, nor does it disclose deleting the temporary email address.

Similarly, it was suggested that as to claim 2, *Nemovicher discloses specific email server, web applications, and client plug-ins to be developed to support anonymous consumers (FIG. 12 [0093]).* However, paragraph 0093 states:

[0093] Referring now to FIG. 12, a process for transmission of secure mail system package 901 to subscriber recipient 420 that uses a web based or unsupported e-mail system is shown. Secure mail system package 901 as assembled by secure mail system server 80 is transferred to mail server 50 for transmission to subscriber recipient 420 over communication network 130. The user at subscriber recipient 420 is notified of the arrival of a new e-mail in their inbox, and can select the message for viewing. Upon selection, resident secure mail system software executes to retrieve and unpack the contents of secure mail system package 901. A private key obtained from subscriber recipient 420 is used to decrypt encrypted random symmetrical one time key 905. Once the random symmetrical one time key is unencrypted, encrypted expanded reformatted message 903 and encrypted secure mail system public key 907 can both be unencrypted using the random symmetrical one time key. The unencrypted expanded reformatted message has a hashing algorithm applied to produce a digital hash code. The secure mail system public key is combined with the digital hash code to verify secure mail system digital signature 911. If secure mail system digital signature 911 cannot be verified, an error message is generated and processing of secure mail system package 901 ceases. Otherwise, secure

mail system digital signature 911 is validated and the expanded reformatted message is displayed to the user of subscriber recipient 420. Again, it is possible to send a return receipt to the message sender at sending computer 400, communicating that the message was properly received and read, or that an error occurred in transmission from mail server 50 to subscriber recipient 420. The return receipt message can be in the form of an e-mail transmitted to the sender at sending computer 400, in a process reverse to that described for sending of the original e-mail message, i.e., via secure mail server 80.

It can thus be seen that this reference does not mention any of these elements. It does not disclose assigning a temporary email address, nor does it disclose forwarding email to that temporary email address, nor does it disclose deleting the temporary email address.

Since the cited reference does not disclose the claimed invention, Applicants respectfully suggest that a *prima facie* rejection for lack of anticipation has been overcome, that the rejection of these claims for this reason is inappropriate, and therefore request that it be withdrawn.

Note also though that the newly added claims require that 1) a temporary email address is assigned a user, 2) email addressed to that temporary email address is forwarded to the user, and 3) a means is provided for deleting the temporary email address. None of the cited references contain all these elements.

Also note that the Nemovicher reference does not address the use of a temporary email address for forwarding email to a user, whatsoever.

The remainder of the claims are dependent upon claims 4, 8, and 12, and should therefore also be allowable.

No new matter has been added by this Amendment, since all newly submitted claims are supported by the specification as originally filed.

Applicants respectfully requests that this Amendment be entered. All claims should be allowable. Applicants further respectfully requests that a timely Notice of Allowance be issued in this case.

Date: July 5, 2007

Respectfully submitted,
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